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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,239	09/17/2003	Neil S. Fox	12947.0002	6288

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EXAMINER

FAISON, VERONICA F

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,239

Applicant(s)

FOX ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9-17-03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Specification

The use of the trademarks "Special Fugitive Yellow Dispersion, No. 121M6669", "Special Fugitive Orange Dispersion, No. 121M6665"; "Special Fugitive Red Dispersion No. 121M6850", "Special Fugitive Red Dispersion No. MT6633; "Special Fugitive Pink Dispersion, No. 121M6832"; and "Special Fugitive Green Dispersion No. 121M6853" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 6 and 25 contains the trademark/trade names trademarks "Special Fugitive Yellow Dispersion, No. 121M6669", "Special Fugitive Orange Dispersion, No. 121M6665"; "Special Fugitive Red Dispersion No. 121M6850", "Special Fugitive Red Dispersion No. MT6633; "Special Fugitive Pink Dispersion, No. 121M6832"; and "Special Fugitive Green Dispersion No. 121M6853". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a pigmented colorant and, accordingly, the identification/description is indefinite.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-24, and 26-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,652,638. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 7-12, 15-21, 23, 24, 26-31, 34, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kummins et al (US Patent 3,975,554).

Kummins et al teach a process for coating a surface with a silicon-containing coating composition wherein the surface to be coated is first primed with a film-forming, silicon-containing primer composition containing a primer-soluble, light-fugitive colorant (col. 2 lines 22-26). The reference further teaches that the light-fugitive colorant present in the primer composition will retain at least some of its color for 24 hours and will subsequently become colorless in the presence of light (col. 2 lines 39-51). The silicon-coating compositions are readily available commercial products including paints and sealants. The surfaces that may be coated with the primer composition include

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concrete, brick and glass (col. 4 lines 10-20). These coating compositions comprise other components such as fillers, catalysts, pigments, curing agents, performance additives such as antioxidants and process aids, solvents and emulsifiers (col. 4 lines 22-52). Kummins also discloses that the coating compositions may be applied by the usual techniques including spreading, trowelling, flowing, rolling, spraying, dipping, smearing and pressing (col. 61-66). The light-fugitive colorant may be red, blue, green, yellow and mixtures thereof (col. 5 lines 27-37). The reference teaches that ultraviolet light is more effective than visible light for destroying colors. The desirable interval of time for loss of color to occur may vary from the time period of one day to 6 weeks after the application of the primer composition to the surface (col. 6 lines 49-60). The reference remains silent to the amount of the additives (i.e. UV absorbers, antioxidants, propellant, and surfactants), however Applicant's ranges are in the conventional ranges of these additives therefore it would have been obvious to use them in the amount as claimed by Applicant. The reference fails to teach a specific pigment, however it would have been obvious to one of ordinary skill to the art that colorant includes dye or pigment and that pigments are used because of better lightfastness properties.

Claims 4, 13, 14, 23, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kummins et al. as applied to claims 1, 2, 5, 16, 17, 19, 20, 21, 24, 36 above, and further in view of Panush (US Patent 4,598,020).

Kummins et al is described above, but fails to specifically teach the exact components of a paint base.

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Panush teaches a paint composition that comprises a basecoat material comprising any suitable film-forming material including acrylics, alkyds, and polyester resins. The reference further teaches that the basecoat may be deposited in an aqueous carrier or volatile organic solvents such as toluene, xylene, and acetone that may be present in the amount of 2 to about 50 percent by weight (col. 3 lines 29-45). The pigment may be present in the composition in the amount of about 1 to about 25 percent by weight (col. 9 lines 47-49).

Therefore it would have been obvious to one of ordinary skill in the art the use the paint base (i.e. basecoat) as taught by Panush because Kummins et al broadly discloses that the primer composition may be used in a paint composition.

Conclusion

The remaining references listed on form 1449 have been reviewed by the Examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


VFF